

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

LEON STAMBLER, )  
 )  
 Plaintiff, )  
 )  
 v. ) Civil Action No. 01-065-SLR  
 )  
 RSA SECURITY, INC., )  
 VERISIGN, INC., )  
 OMNISKY CORPORATION, )  
 )  
 Defendants. )

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**MEMORANDUM OPINION**

Dated: January 29, 2003  
Wilmington, Delaware

**ROBINSON, Chief Judge**

**I. INTRODUCTION**

On February 2, 2001, plaintiff Leon Stambler ("Stambler") filed this action against defendants RSA Security, Inc. ("RSA Security"), Verisign, Inc. ("Verisign"), and Omnisky Corporation ("Omnisky") alleging infringement of certain claims of United States Patent Nos. 5,793,302 (the "'302 patent"), 5,936,541 (the "'541 patent") and 5,974,148 (the "'148 patent) (collectively, the "Stambler patents"). (D.I. 1)

The court has jurisdiction over this matter pursuant to 28 U.S.C. §§ 1331, 1338(a) and 2201(a). Currently before the court is defendant Verisign's motion for summary judgment of non-infringement and invalidity of claim 12 of the '302 patent. (D.I. 274) For the following reasons, the court shall grant in part and deny in part defendant's motion.

**II. BACKGROUND**

The Stambler patents, each entitled "Method for Securing Information Relevant to a Transaction," generally relate to a method of authenticating a transaction, document or party to a transaction using known encryption techniques. (D.I. 293, 294, 295) The patented methods enable parties to a transaction to assure the identity of an absent party and the accuracy of information involved in the transaction. (Id.) The patented methods thus provide for secure transactions and prevent fraud. (Id.)

### III. STANDARD OF REVIEW

A court shall grant summary judgment only if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. See Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 n.10 (1986). "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct." Horowitz v. Fed. Kemper Life Assurance Co., 57 F.3d 300, 302 n.1 (3d Cir. 1995) (internal citations omitted). If the moving party has demonstrated an absence of material fact, the nonmoving party then "must come forward with 'specific facts showing that there is a genuine issue for trial.'" Matsushita, 475 U.S. at 587 (quoting Fed. R. Civ. P. 56(e)). The court will "view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion." Pa. Coal Ass'n v. Babbitt, 63 F.3d 231, 236 (3d Cir. 1995). The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there

must be enough evidence to enable a jury reasonably to find for the nonmoving party on that issue. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. See Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986).

#### **IV. DISCUSSION**

##### **A. Infringement**

A determination of infringement requires a two-step analysis. First, the court must construe the asserted claims so as to ascertain their meaning and scope. Second, the claims as construed are compared to the accused product. See KCJ Corp. v. Kinetic Concepts, Inc., 223 F.3d 1351, 1355 (Fed. Cir. 2000). Claim construction is a question of law while infringement is a question of fact. See id. To establish literal infringement, "every limitation set forth in a claim must be found in an accused product, exactly." Southwall Tech., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1575 (Fed. Cir. 1995). An accused product that does not literally infringe a claim may still infringe under the doctrine of equivalents if each limitation of the claim is met in the accused product either literally or equivalently. See Sextant Avionique, S.A. v. Analog Devices, Inc., 172 F.3d 817, 826 (Fed. Cir. 1999).

Claim 12 of the '302 patent recites:

12. A method for enrolling and issuing a credential to a first party by a second party, and subsequently granting the first party access to a first storage means, wherein the first party has a first personal identification number (PIN1), and the second party is previously granted authority to issue a credential to the first party, the first storage means, being accessible only to a party with knowledge of the first PIN1, the method of enrollment and issuing a credential comprising:

- receiving information associated with the first party;
- receiving information associated with the second party;
- storing in escrow and in trust the information associated with the first party and the information associated with the second party in a second storage means, wherein at least a portion of the information retrieved from the second storage means is used in enrolling the first party and issuing the credential; and
- subsequently granting the first party access to the first storage means by using the PIN1 or the credential.

('302 patent, col. 26, ll. 10-29)

Having heard oral argument and reviewed extensive briefing by the parties, the court has construed the relevant claim limitations as follows:

**"The First Party Has a First Personal Identification Number (PIN1)"** The term "the first party has a first personal identification number (PIN1)" shall be construed to mean "at the time the method steps are executed, the first party has a number for identification that is secret, is selected by the first party at the time of enrollment, cannot exist in uncoded form, and cannot be recovered from other information anywhere in the system." ('148 patent, col. 2, ll. 31-36; D.I. 293 at 383)

**"First Storage Means"** The term "first storage means" shall be construed to mean "a first place for storing information, which can include a computer file."

**"Subsequently Granting the First Party Access to the First Storage Means by Using the PIN1 or the Credential"** [T]he term "subsequently granting the first party access to the first storage means by using the PIN1 or the credential" shall be construed to mean "the step of subsequently granting the first party access to the first storage means by using the PIN1 or the credential must occur after the previous steps of the method have been performed, including the step of issuing the credential to the first party."

Defendant has also asserted the following facts, which are uncontested by plaintiff:

(1) Verisign issues digital certificates to Internet merchants and other users to authenticate their websites and their e-mail addresses.

(2) Users enroll for a digital certificate by contacting Verisign through an Internet website. The user completes an information template about themselves and submits the information to Verisign. The template information is loaded into a computer file in Verisign's database. A unique order number correlates that template information to that user. The identity of the user is then verified by Verisign.

(3) After the user is enrolled and his identity is verified, Verisign sends an e-mail to the user indicating that verification is complete and that his or her digital certificate can be obtained. The e-mail message from Verisign contains a personal identification number (PIN) generated by Verisign for the user. This Verisign-selected PIN correlates to, and can be recovered from, the order number.

(4) The user then goes to Verisign's website and enters the Verisign-selected PIN. This triggers the issuance of the user's digital certificate from Verisign to the user's computer.

(5) Three categories of accused Verisign processes do not use any PIN: (a) Verisign's OFX

Financial Server ID's, (b) On-Site "Server" Certificates, and (c) all "automatically" authenticated On-Site "Client" Certificates.

(6) Every storage database file in Verisign's certificate issuance system is accessible to and by Verisign.

(D.I. 275 at 3-5)

Based on the above facts and claim construction, defendant Verisign asserts that no reasonable jury could find literal infringement of claim 12. Defendant argues that it does not meet three of the claim limitations: (1) the user does not have a PIN1; (2) there is no first storage means accessible only to the user; and (3) access to a first storage means is not granted using the PIN after the certificate is issued. Plaintiff asserts that, even under defendant's claim construction, "genuine issues of material fact remain as to whether Verisign's accused processes infringe claim 12 under the doctrine of equivalents."

(D.I. 321 at 3)

#### **1. PIN1**

Plaintiff has failed to make an argument for literal infringement under the court's claim construction of the term PIN1. This is not surprising. PIN1, as defined by the '302 patent specification and prosecution history, must be selected by the user and must not be recoverable from other information in the system. Defendant's process involves PIN selection by Verisign and the PIN can be recovered from the order number.

Thus, the court finds that no reasonable jury could find literal infringement of claim 12.

Plaintiff argues that defendant's PIN performs substantially the same function, in substantially the same way, to achieve substantially the same result as the PIN of claim 12 and, thus, infringes under the doctrine of equivalents. "Infringement under the doctrine of equivalents requires an intensely factual inquiry." Leggett & Platt, Inc. v. Hickory Springs Mfg. Co., 285 F.3d 1353, 1357 (Fed. Cir. 2002) (quoting Vehicular Tech. Corp. v. Titan Wheel Int'l, Inc., 212 F.3d 1377, 1381 (Fed. Cir. 2000)). Defendant has not met its burden to show that no reasonable jury could find infringement under the doctrine of equivalents. Thus, the court finds that a genuine issue of fact remains regarding infringement under the doctrine of equivalents.<sup>1</sup>

## **2. First Storage Means**

Defendant also argues that no reasonable jury could find literal infringement based on the "first storage means"

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<sup>1</sup>Defendant also contends that certain processes do not use a PIN of any form. Plaintiff has failed to respond to this argument. As a matter of law, any processes that do not use a PIN cannot infringe claim 12 either literally or under the doctrine of equivalents. Thus, the court finds that the three categories of processes identified by defendant (Verisign's OFX Financial Server ID's, On-Site "Server" Certificates, and all "automatically" authenticated On-Site "Client" Certificates) do not infringe claim 12 literally or under the doctrine of equivalents.

limitation. The court disagrees. The claim language states that the first storage means must "[be] accessible only to a party with knowledge of the first PIN1[.]" Defendant argues that access is only permitted by the user. The claim language, however, does not limit access only to the user. Access is limited to parties with knowledge of PIN1, which may include additional parties as well as the user. During prosecution, Stambler amended the claim to eliminate access using a second PIN2, but did not amend the claim to eliminate access by additional parties. Thus, a reasonable jury may find the accused process has a "first storage means."

### **3. Subsequently Granting Access**

Based on the court's claim construction, no reasonable jury could find defendant's processes literally infringe claim 12. Defendant grants access to the storage means using a PIN. After access is granted, the credential is issued. The claim requires the ability to gain access to the storage means using the credential alone, thus, the court construed the claim to require the granting of access subsequent to the issuance of the credential. As the steps are reversed in the accused process from that of claim 12, no reasonable jury could find literal infringement.

### **B. Invalidity**

Defendant asserts that claim 12 is invalid because the patent fails to meet the written description requirement of 35 U.S.C. § 112. Specifically, defendant asserts that the patent does not disclose how to access the first storage means using the PIN1 **or** the credential. According to defendant, "every embodiment in the specification uses the PIN together with a credential, or a PIN alone (without using a credential), to access the claimed first storage means." (D.I. 275 at 13) Plaintiff responds by asserting that one of ordinary skill in the art would understand that Stambler contemplated an invention having a storage means accessible using a PIN or credential.

The written description requirement of section 112 states in relevant part:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same."

35 U.S.C. § 112, ¶ 1. The Federal Circuit has noted that

[i]n written description cases, [t]he primary consideration is *factual* and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure . . . .The written description requirement does not require the applicant to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed. Thus, § 112, ¶ 1 ensures that, as of the filing date, the inventor conveyed with reasonable clarity to those of skill in the art that he was in possession of the subject matter of the claims.

Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 996-97 (Fed. Cir. 2000) (emphasis in original) (internal citations and quotations omitted).

In the case at bar, plaintiff's expert has opined that "[t]he patent does describe granting access to a storage means using information on a credential without using a PIN." (D.I. 317 at ¶ 74) Defendant argues that this is insufficient because the embodiments cited by plaintiff's expert do not disclose accessing the first storage means with only the credential. However, "[t]he written description requirement does not require the applicant to describe exactly the subject matter claimed." Union Oil Co., 208 F.3d at 996-97. The relevant question is, does the description clearly allow persons of ordinary skill in the art to recognize that Stambler invented what is claimed? The answer to that question calls for factual resolutions by the jury.

#### **V. CONCLUSION**

For the reasons stated, the court shall grant in part and deny in part defendant's motion for summary judgment of non-infringement and invalidity of claim 12 of the '302 patent. An appropriate order shall issue.

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 FIRST DATA CORPORATION, )  
 OMNISKY CORPORATION, )  
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 Defendants. )

**O R D E R**

At Wilmington, this 29th day of January, 2003, consistent with the opinion issued this same day;

IT IS ORDERED that:

1. Defendant Verisign's motion for summary judgment of literal non-infringement of claim 12 of the '302 patent (D.I. 274) is granted.

2. Defendant Verisign's motion for summary judgment of non-infringement of claim 12 of the '302 patent under the doctrine of equivalents (D.I. 274) is denied.

3. Defendant Verisign's motion for summary judgment of invalidity of claim 12 of the '302 patent (D.I. 274) is denied.

Sue L. Robinson  
United States District Judge